

## **Remarks**

The Applicants are amending Claim 15 to further indicate that the composition is for administration to an animal. Support for the amendment can be found on the last paragraph of page 22 of the Specification.

There are no amendments to the Specification at this time.

### **Double Patenting Rejection**

The Examiner rejected Claims 12-17 under the judicially created doctrine of obviousness-type double patenting, citing Claims 1-7 of U.S. Patent 6,239,077. The Examiner stated that while the claims are not identical, they are not patentably distinct from each other because there is considerable overlap between the instant claims and the claims in the USPN 6,239,077.

The Applicants would like to point out that U.S. Patent 6,239,077 has different inventors than the Applicants and that it is assigned to a different company. As such, the rejection under the judicially created doctrine of obviousness-type double patenting is not appropriate at this time. Applicants request that the Examiner withdraw this rejection.

However, with the intention of moving along the prosecution of this application, the Applicants would like to point out how the claims in this pending Application are not obvious based on Claims 1-7 of U.S. Patent 6,239,077. Applicants point out that U.S. Patent 6,239,077 is related to EP 0 953 565 which Applicants disclosed in an IDS.

The currently pending claims in this Application are directed to a method of controlling a pest in an animal by applying certain compounds to the animal and compositions containing those compounds. The pests are further restricted to be endoparasites (Claim 13) and further restricted to be helminthes (Claim 14). But these claims all require that the specific compounds mentioned in Claim 12 be administered to an animal where the compounds are active, not to plants.

In contrast, U.S. Patent 6,239,077 discloses compounds similar to the present claimed compounds and use of these compounds on plants to kill insects (see Column 26, line 46 through Column 27, line 57. These compounds are applied to paddy field water, stems and leaves or soil, such as paddy field, farm, fruit trees, vegetables, other crops, and flowers (see Column 27, lines 45-47). U.S. Patent 6,239,077 fails to mention that these compounds can be applied to animals for control of pests and fails to teach it. There is nothing in U.S. Patent 6,239,077 which would make it obvious to one skilled in the art that when one applies the

compounds to an animal, that the compounds will kill the pests on or in the animal but not hurt the animal itself. As such, Claims 12-14 are not obvious based on U.S. Patent 6,239,077.

The Examiner stated that Claim 15 is drawn to compositions containing specific species which are obvious variants of compositions embraces by the genus of U.S. Patent 6,239,077. The Examiner states that the genus is rendered obvious by the species.

Again, the Applicants would respectfully point out that U.S. Patent 6,239,077 describes compounds useful for agriculture, not useful for controlling pests inside another animal. There is no teaching in U.S. Patent 6,239,077 about the ability to use the species compounds in compositions which are administered to an animal and which can kill pests in the animal.

The Examiner wrote that "it would have been obvious to one skilled in the art at the time the invention was made to have a reasonable expectation that the claimed compositions would also be useful for controlling pests in view of the close structural similarities outlined above."

The Applicants respectfully disagree. As the Examiner pointed out, U.S. Patent 6,239,077 teaches using various compounds to control pests in agriculture, forestry, horticulture, and stored products. In these described usages, the compounds are not taken internally by an animal, except maybe the nematode and vermin. U.S. Patent 6,239,077 does not teach that the compounds are not toxic to non-pest animals. Rather, U.S. Patent 6,239,077 teaches that "sanitary vermin" are killed by the compounds which **teaches away** from giving compositions containing the compounds to other animals and not harm those animals. So, it is Applicants' belief that U.S. Patent 6,239,077 teaches away from pending Claims 12-17 and that Claims 12-17 are allowable.

#### Double Patenting

The Examiner rejected Claims 12-17 under a provisional nonstatutory double patenting rejection based on co-pending U.S. Application 10/466,824.

While not conceding the merits of the Examiner's argument, Applicants are willing to file a Terminal Disclaimer to overcome this provisional Double Patenting rejection, should Claims 6-11 of U.S. Application 10/466,824 and Claims 12-17 of this pending application become allowed.

The Applicants have not amended the claims. This Amendment is being filed within the shorten statutory time limit. As such, the Applicants believe that no fee is due. However, the Applicants authorize the Commissioner to deduct whatever fee is necessary to maintain the pendency of this application from Deposit Account 19-0134 in the name of Novartis.

Should the Examiner believe that a discussion with the undersigned would aid in the examination of this application, the Examiner can contact the undersigned at the number indicated below.

Respectfully submitted,

Novartis  
Corporate Intellectual Property  
One Health Plaza, Building 430  
East Hanover, NJ 07936-1080  
(862) 778-7922

  
David L. Marks  
David L. Marks  
Attorney for Applicants  
Reg. No. 37,881

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